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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,306	11/09/2000	Kazuo Sako	14051	5037

23389 7590 12/27/2002

SCULLY SCOTT MURPHY & PRESSER, PC
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GARDEN CITY, NY 11530

EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,306

Applicant(s)

SAKO, KAZUE

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-22 have been examined.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed on 9 November 2000.

Information Disclosure Statement

3. The information disclosure statement filed 9 November 2000 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because section (a)(3)(i) of 37 CFR 1.97, 1.98 and MPEP § 609 requires "a concise explanation of relevance, as it is presently understood by the individual designated most knowledgeable about the content of the information." Or "a copy of the translation if a written English-language translation of non-English-language document." It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Drawings

4. Claims 1, 8, and 15 are objected to because in the paragraph 2 there is no depiction of the said step in the figures. It is not clear who the receiver of said electronic revenue stamp is. Is it the postal system or end recipient and how this issued revenue stamp is depicted.
5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the step for "issuing means for issuing said electronic revenue stamp as data attached a signature of said electronic revenue stamp issuing apparatus to

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a message to be attached to said electronic revenue stamp, the amount of said electronic revenue stamp, and an identifier of a receiver of said electronic revenue stamp, in case that said amount of said electronic revenue stamp is equal to or less than said possible amount to issue" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claim 15 is rejected under 35 U.S.C. 101 because no concrete and/or tangible results are achieved based on the mere fact of storing programs on a recording medium. The recording medium by itself alone can not generate or create any tangible or concrete results without being in communication with a system that can use the stored executable programs.

Same applies to the claims 16-21 as they are dependent claims to claim 15.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. The claims 1-21 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

9. Claims 1, 8, and 15, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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10. As per claims 1, 8, and 15, it is not clear to the examiner that in, Paragraph 2, it is implied even if there is insufficient funds for the revenue stamp issuing means to issue a revenue stamp, the revenue stamp is issued along with additional data attached. The commonly practiced revenue stamp issuing system today prevents any stamp to be issued if there is an insufficient fund. Paragraph 3, of the claims 1, 8, and 15, it is understood that the common practice in stamp revenue issuing system not to issue revenue stamps unless there is sufficient funds. Examiner is not clear on, why the revenue stamp is issued if there are insufficient funds. How the extra funds can be deducted from an insufficient fund?

11. Claims 2, 9, and 16 recites the limitation "receives a certificate" in accordance to claims 1, 8, and 15. There is insufficient antecedent basis for this limitation in the claims 1, 8, and 15. Examiner is not clear how the invalidating certificate is generated. How it is known and certified that the revenue stamp is invalid? There is no indication of how this determination of invalidation has been made.

12. Claims 2-7, 10-14, and 17-21 are rejected in the same manner as being dependent claims to the above claims.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

14. Claims 1, 8, ¹⁵16, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,260,028 to David K. Lee.

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15. As per claim 22, a recording medium stored a control program of an electronic revenue stamp issuing method, wherein:

- said recording medium stored said control program of said electronic revenue stamp issuing method is an IC card (See Lee figures 1, 2, 3 and 7 and associated text, abstract, and column 5, line 20-68, column 6, lines 1-68 and column 7, lines 1-64).

16. As per claims 1, 8, and 15, an electronic revenue stamp issuing apparatus, comprising:

- a judging means for judging whether the amount of an electronic revenue stamp to be issued is equal to or less than a possible amount to issue in which a prepaid amount is stored or not (See Lee figures 1, 2, 3 and 7 and associated text, abstract, and column 5, line 20-68, column 6, lines 1-68 and column 7, lines 1-64);
- an issuing means for issuing said electronic revenue stamp as data attached a signature of said electronic revenue stamp issuing apparatus to a message to be attached to said electronic revenue stamp, the amount of said electronic revenue stamp, and an identifier of a receiver of said electronic revenue stamp, in case that said amount of said electronic revenue stamp is equal to or less than said possible amount to issue (See Lee figures 1, 2, 3 and 7 and associated text, abstract, and column 5, line 20-68, column 6, lines 1-68 and column 7, lines 1-64); and
- a balance amount reducing means for reducing said amount of said electronic revenue stamp from said possible amount to issue; when said electronic revenue stamp was issued (See Lee figures 1, 2, 3 and 7 and associated text, abstract, and column 5, line 20-68, column 6, lines 1-68 and column 7, lines 1-64).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 2-7, 9-14, and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,260,028 to David K. Lee in view of U.S. Patent 6,058,384 to Perry A. Pierce et al.

19. As per claims 2, 9, and 16, Lee discloses all the limitations of claims 1, 8, and 15, further; What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches how,

- a verifying means, when said verifying means receives a certificate making electronic revenue stamp invalid attached to a signature of said receiver, verifies whether said certificate making electronic revenue stamp invalid is valid or not by using said identifier of said receiver (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53);
- an amount increasing means for increasing said possible amount to issue by said amount of said electronic revenue stamp made to be invalid (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53); and
- an invalid electronic revenue stamp recording means for recording said certificate making electronic revenue stamp invalid that was made to be invalid (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time, and better security control of refunding unused revenue stamps.

20. As per claims 3, 10, and 17, Lee discloses all the limitations of claims 1, 8, and 15, further;

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What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches how,

- said issuing means issues said electronic revenue stamp as data attached said signature of said electronic revenue stamp issuing apparatus to an issued number (a serial number) of said electronic revenue stamp issuing apparatus to specify said electronic revenue stamp, in addition to said message to be attached to said electronic revenue stamp, the amount of said electronic revenue stamp, and said identifier of said receiver of said electronic revenue stamp (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time, and better security control of refunding unused revenue stamps.

21. As per claims 4, 11, and 18, Lee discloses all the limitations of claims 2, 9, and 15, further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches how,

- said verifying means, when said verifying means receives said certificate making electronic revenue stamp invalid attached said signature of said receiver, verifies whether said certificate making electronic revenue stamp invalid is valid or not, by using said identifier of said receiver and an issued number (a serial number) of said electronic revenue stamp issuing apparatus; when said electronic revenue stamp issuing apparatus gives said issued number to said electronic revenue stamp (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time, and better security control of refunding unused revenue stamps.

22. As per claims 5, 12, and 19, Lee discloses all the limitations of claims 2, 9, and 15, further; What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches how,

- invalid electronic revenue stamp data in which data of electronic revenue stamps made to be invalid are stored (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time, and better security control of refunding unused revenue stamps.

23. As per claims 6, 13, and 20, Lee discloses all the limitations of claims 1, 8, and 14, further; What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches how,

- an issued electronic revenue stamp recording means which records issued electronic revenue stamps (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53); and
- issued electronic revenue stamp and invalid electronic revenue stamp data in which data of said issued electronic revenue stamp data and electronic revenue stamps made to be invalid are stored when said electronic revenue stamps are made to be invalid (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time, and better security control of refunding unused revenue stamps.

24. As per claims 7, 14, and 21, Lee discloses all the limitations of claims 2, 9, and 15, further; What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches how,

- said verifying means verifies that said certificate making electronic revenue stamp invalid is issued for an electronic revenue stamp issued by said electronic revenue stamp issuing apparatus and also issued by a receiver who is an valid receiver of said electronic revenue stamp, and also verifies that said certificate making electronic revenue stamp invalid was not used before (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time, and better security control of refunding unused revenue stamps.

Conclusion

25. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

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26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

Abdi/K
December 23, 2002

JOHN W. HAYES
John W. Hayes
PRIMARY EXAMINER